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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,856	08/13/2001	Jeff S. Vigil	SLA1081	8273
21552	7590	12/14/2004	EXAMINER	
MADSON & METCALF GATEWAY TOWER WEST SUITE 900 15 WEST SOUTH TEMPLE SALT LAKE CITY, UT 84101			HAILU, TADESSE	
			ART UNIT	PAPER NUMBER
			2173	
DATE MAILED: 12/14/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,856

Applicant(s)

VIGIL ET AL

Examiner

Tadesse Hailu

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Amendment submitted/entered on August 6, 2004 for the patent application (09/928,856) filed on August 13, 2001.

Status of the claims

2. The pending claims 1-40 are examined herein as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 10, 13-24, 26, 29-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al (US Pub. No. 20020112014).

With regard to claim 13:

Bennett discloses one or more messaging system including web based messaging systems (Fig. 6). The user 12 (wireless device) manipulates and sends an SMS message using the "web" of Internet ([0023]). As illustrated in Fig. 1, and 1A, Bennett discloses a multi mobile network message delivery system. The delivery system comprises a web site or server 24 for editing and storing (database 22) pre-configured (or pre-packaged) ([1003]) messages to be used with hand-held wireless telecommunications devices (user 14, 16, and 20).

The web site of Bennett further includes, among other things, a web server (Fig. 1, server 24) for serving web data to a plurality of wireless devices ([0023], [0037]).

As illustrated in Fig. 1, the system 10 of Fig. 1 shows different users 12, 14 and 16 sending (via wireless device/pc) message to an end user 20 through a server 24 (web server), the server being in electronic communication with routing database 22 (a storage device) that stores instructions executable by the server computer ([0021]-[0024]).

Bennett further discloses allowing a wireless device (Fig. 1, user 14) to contact the web site via a global computer network (Figs. 1, 1A).

Bennett further discloses before a user is sending a message to another user the server 24 identifies the sender through registration process. The server 24 obtains or receives user's data through the registration process ([0059], [0071], [0073]).

Bennett further discloses sending an address list (such as phone list or e-mail address) identified through use of the user identification from the server/database (web site) to the wireless device ([0076], [0071], [0082], [0086]).

Bennett further discloses sending a plurality of pre-configured (pre-packaged) ([0103]) messages identified through use of the user identification from the web site to the wireless device ([0037], [0103], [0189]).

Bennett further discloses providing to a mobile user an interface to select and enter a recipient from a address book or buddy list or from plurality of phone list (Fig. 6, [0074], [0081], [0134], [0143]); Bennett also discloses a message user interface (e.g. web page) for editing messages or selecting message from the previously stored messages, that is, content retrieved from database 22 ([0069], [0071], [0074]).

Lastly, Bennett discloses routing or sending the message to the recipient through the Internet network ([0079], [0082], [0173]).

With regard to claim 14:

Bennett further discloses storing the pre-packed (pre-configured) messages on the database 22 (storage device) (Fig. 1).

With regard to claim 15:

Bennett discloses a web page (user interface) may be displayed to a user in connection with entering message information ([0071]). Bennett further discloses user is able to reformat a message, such as changing the dynamic part of the message, e.g. as illustrated in Fig. 3, Bennett discloses message having dynamic field that can be changed. For example as illustrated in Fig. 3, #122b, SMS body text displays -- *Soames Hola Scames, hows the baby? --*, *Wherein* Soames is a dynamic field (or token) that can be replaced by another name ([0103]-0105)).

With regard to claims 7 and 23:

Bennett further discloses exchanging e-mail among plurality of users via the web site or server computer network (Fig. 1, [[0050], [0052], [0055])

With regard to claims 1 and 29:

Bennett discloses a method executed in a computer system for routing a message (pre-packaged information) ([0103]) from a sender in a first digital mobile network to a receiver (recipient) in a second different digital mobile network ([0006-0007]). The sender device is a typical hand-held wireless telecommunications device, which typically includes, among other things, a processor, an input device, a display, and a memory.

The method includes, among other things, facilitating communication among a plurality of different telecommunications systems (abstract).

The method also includes facilitating communications between a cell phone and the server 24, such as the TIAXA server, wherein the server 24 previously stores within database 22 pre-packed messages (FIG. 1, [0059], [0062], [0114], [0131], [0156]).

The method also includes obtaining or consulting for the recipient's, e.g., phone number, etc (address) from the routing database 22. In other words, the routing is queried as to the existence or entry of the recipient's address (e.g., phone number) within the routing database 22 ([0076]). In order to obtain a recipients phone number, the user may be required to register (identifying user), or to enter a country as well as a phone number or MIN (mobile identification number). Then, the database may be consulted, and the correct countrywide MIN may be returned to the user to serve as a template for user entry in connection with user registration ([0071], [0082]).

Alternatively, the method also includes accessing a buddy (recipient) list rather than go through a process of consulting the database for complete information, wherein the buddy list includes user specific information for message recipients ([0086]);

The method also includes the routing database 22 may then return to the wireless device 10 the requested address (e.g., phone number, e-mail address) of the recipients ([0124], [0125], [0135]).

The method also includes providing to a mobile user an interface to select and enter a recipient from an address book (buddy list) or from plurality of phone list (Fig. 6, [0074], [0081], [0134], [0143]).

The method also includes the register user may communicate directly with the Server to obtain the information (pre-packaged message) requested. Alternatively, a user may communicate to the user's host SMSC. The method also includes that the server may then poll the host SMSC to receive the user's request for information ([0037], [0103], [0189]).

As illustrated in FIG. 6, the method also includes a message user interface (e.g. web page) for editing messages or selecting message from the previously stored messages that is, content retrieved from database 22 ([0069], [0071], [0074]).

Lastly, the method also includes routing or sending the message to the recipient through the Internet network ([0079], [0082], [0173]).

With regard to claim 30:

Bennett further discloses that a web page may be displayed to a user in connection with entering message information. The user may enter this information, for

example, from a personal computer, a wireless access protocol, or "WAP" phone, or other device having Internet capabilities ([0071], [0072], [0074]).

With regard to claims 16 and 31:

PIM data, as defined in the current invention (page 7, lines 13) is "Personal information manager" data. "PIM software typically organizes and stores names, addresses, notes contact information, a calendar, etc." similarly, Bennett teaches the claimed, PIM element, wherein Bennett further discloses receiving or pulling personal data, such as contact information (PIM data) or Personal Information manager data, such as buddy list and storing said personal data on the server, database 22 ([0102], [0111]).

With regard to claims 17 and 32:

Bennett further discloses in addition to the above claims (16 and 31), the buddy list, personal data or the contact information data (PIM data) is also applies for a personal digital assistance transferred to the client computer from personal digital assistance PDA ([0027]), and storing said personal data on the server, database 22 ([0102], [0111]).

With regard to claims 2, 18 and 33:

Bennett further discloses that the wireless device is a mobile telephone (Fig. 1, #14).

With regard to claims 3, 19, and 34:

Bennett further discloses that the wireless device is a personal digital assistant (PDA) ([0027]).

With regard to claims 4, 20, and 35:

As described above Bennett discloses user exchanging text messages (SMS) with a recipient (Abstract).

With regard to claims 5, 6, 21, 22, and 36:

Bennett discloses reformatting text message in accordance with the appropriate format (0105). Bennett also discloses "dynamic keyword" in connection with message 122b ([0097], [0195]). The current invention defines (page 10, lines 2) the claimed, "token" element as a dynamic field that may be changed. Thus, similarly Bennett discloses message having dynamic field that can be changed. For example as illustrated in Fig. 3, #122b, SMS body text displays -- *Soames Hola Scames, hows the baby?* --, *Wherein* Soames is a dynamic field (or token) that can be replaced by another name.

With regard to claims 8, 24, and 37:

Bennett further includes, among other things, a network data including WML ([0058], [0074]).

With regard to claims 10, 26, and 38:

Bennett's user interface further includes among others, HTML instructions ([0058], [0074], [0077]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 11, 12, 25, 27, 28, 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (US Pub. No. 20020112014) in view of Gargiulo et al (US Pub. No. 20020087656).

With regard to claims 9, 11, 12, 25, 27, 28, 39 and 40:

Bennett's user interface further includes among others, HTML instructions ([0058], [0074], [0077]). But Bennett's user interface does not disclose XML, HDML and XHTML. Gargiulo discloses message communication in wireless networks via a network. Gargiulo further discloses one or other mark-up languages such as XHTML ([0025]), HDML ([0040]) and XML ([0040]). Bennett and Gargiulo are analogous art because they are from the same field of endeavor that is text messaging. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to substitute the HTML of Bennett with XHTML, XML, or DHTML of Gargiulo because instruction programs capable of interpreting XML, DHTML, or XHTML are able to properly interpret HTML formatted documents. Such programs can be considered "HTML-compliant."

Response to Arguments

5. Applicant's arguments filed August 6, 2004 have been fully considered but they are not persuasive. Applicant argues the rejection of claims 1-40.

The Applicant argues Bennett does not anticipate each and every element of claims 1-8, 10, 13-14, 26, and 29-38. The Examiner disagrees because Bennett discloses a Messaging systems, or messaging modules such as those used in cellular

networks for mobile telecommunications, wherein each employ their own messaging and address formats (paragraph 3). As illustrated in Fig. 1, Bennett messaging system at least in part, includes a hand held devices (e.g., 14, 16 and 2, PC (12) and , a web server (24), wherein each device includes a processor to execute instruction. Again as illustrated in Fig. 1, the wireless device is connected to Internet (global computer network). The hand held device (e.g., mobile phone 16, 14 or 20) displays a network data received from server 24 (Fig. 1, paragraphs 20-24). As illustrated in Fig. 1, the messaging system enables the user to establish communication with a message web site (e.g. server 24) (paragraphs 20-24). The messaging system also provides a recipient, such as buddy list to select a receipt (paragraphs 59, 71, and 73). The messaging system also includes obtaining or consulting for the recipient's, e.g., phone number, etc (address) from the routing database 22 In other words, the routing is queried as to the existence or entry of the recipient's address (e.g., phone number) within the routing database 22 (paragraphs 76, and 86). The messaging system also includes providing a user a message user interface (e.g. WAP phone, web PC, SMS phone, Fig. 1). The WAP or the browser enables the user to manipulate messages. For example, as the mobile device (16) may receive previously edited and stored messages from server 24, then the mobile device displays and edit or select any one of the messages to send to mobile device (20).

With regard to the rejection of claims 9, 11, 12, 25, 28, 39, and 40, the Applicant argues that a prima facie case of obviousness has not been established and that claims 9, 11, 12, 25, 28, 39, and 40 are patentable over Bennett in view of Gargiulo. Again the

Examiner disagrees because a prima facie case of obviousness has been established and that claims 9, 11, 12, 25, 28, 39, and 40 are not patentable over Bennett in view of Gargiulo. Bennett discloses a message module including at least in part a user interface (WAP phone, web PC, SMS phone, etc (Fig. 1,) for manipulating messages. Bennett further teaches receiving from the wireless device a user identification. Bennett discloses a method executed in a computer system for routing a message from a sender in a first digital mobile network to a *receiver* in a second different digital mobile network, wherein a routing database is used to relate an *identification* number associated with the *receiver* to corresponding routing path information associated with the second digital mobile network (see paragraphs 6, 7, 94, 95, etc). Furthermore, Bennett in view of Gargiulo discloses XHTML (paragraph 25), HDML and XML (paragraph 40) as specified in the claims.

Having fully addressed the Applicant's arguments, the rejection still stands.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2173

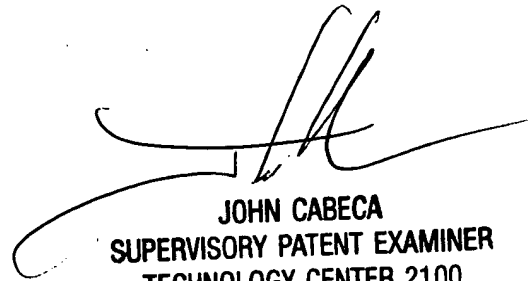
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 273-4048 Art Unit 2173.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Tadesse Hailu

12/01/04



JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100